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Applicant:	Michael Poirier
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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Sir

This paper is submitted in response to the Final Office Action mailed September 20, 2005. A Notice of Appeal accompanies this response.

Argument begins on page 2 of this paper.

ARGUMENT

Status

In the final Office action dated September 20, 2005, the Examiner rejected:

(a) Claims 1-2, and 4-6 as being anticipated by Robinson et al. (U.S. Pat. No. 5,374,395);

(b) Claim 3 as being obvious over Robinson et al. (U.S. Pat. No. 5,374,395).

In support of the anticipation rejections, the Examiner recites selected limitations of the presently pending claims and correlates these to various elements in Robinson's specification (see page 2 and 3 of final Office action). Similarly, in support of the obviousness rejections selected limitations of the presently pending claims were correlated with various elements in Robinson's specification, and the Examiner then alleged that substitution of an antibody for a nucleotide probe would have been obvious (see page 4 of final Office action).

In response to the applicant's previous arguments, the Examiner appeared to concede, but indicated that such arguments would be moot in light of her new rejection.

The Examiner Fails To Identify Each And Every Claimed Limitation In The Cited Reference

Claims 1-2, and 4-6

Anticipation under 35 U.S.C. § 102 requires the presence in a single prior art disclosure of ***each and every element of a claimed invention***. *Verdegaal Bros., Inc. v. Union Oil Co.*, 814 F.2d 628, 631, 2 U.S.P.Q.2D (BNA) 1051, 1053 (Fed. Cir. 1987); *Carella v. Starlight Archery*, 804 F.2d 135, 138, 231 U.S.P.Q. (BNA) 644, 646 (Fed. Cir.), *modified on reh'd*, 1 U.S.P.Q.2D (BNA) 1209 (Fed. Cir. 1986); [**7] *Jamesbury Corp. v. Litton Indus. Prods., Inc.*, 756 F.2d 1556, 1560, 225 U.S.P.Q. (BNA) 253, 256 (Fed. Cir. 1985); *Lindemann Maschinenfabrik GMBH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 1458, 221 U.S.P.Q. (BNA) 481, 485 (Fed. Cir. 1984); *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 1548, 220 U.S.P.Q. (BNA) 193, 198 (Fed. Cir. 1983).

Moreover, anticipation under Section 102 requires "the presence in a single prior art disclosure of all elements of a claimed invention ***arranged as in that claim***." *Panduit Corp. v. Dennison Manufacturing Co.*, 774 F.2d 1082, 1101, 227 U.S.P.Q. (BNA) 337, 350 (Fed. Cir.

1985) (quoting *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 1548, 220 U.S.P.Q. (BNA) 193, 198 (Fed. Cir. 1983)).

As applied to the present case, independent claim 1 (and claims 2-6 by virtue of their dependence on claim 1) expressly requires (a) that the "...the fluid receiving port is ***configured to receive a continuous flow*** of a biological fluid...", (b) that the "...the fluid discharge port is ***configured to emit a continuous flow*** of the biological fluid...***while the fluid receiving port receives the continuous flow*** of the biological fluid...", and (c) that the ***magnetic force*** and the ***automatic mechanical force*** are ***transmitted through the flexible top sheet.***

These limitations are clearly not correctly identified by the Examiner. While the Examiner provides column and line information for her assertion (see last line page 2 of final office action, and last line first paragraph on page 3 of final office action), it was left entirely unclear how such passages would possibly apply.

Furthermore, it should be noted that the '395 expressly teaches in numerous places against continuous influx of a sample fluid while a continuous efflux of depleted sample fluid is emitted. For example, the sample container in Robinson is disposed in a carousel that assists in transportation of the container within the device. Clearly, as the sample is placed into the container before the container is loaded into the device, ***continuous loading and effluent provision is not achieved*** (see e.g., column 35, lines 29 et seq.). Further, and more specifically, Robinson et al. teach (on column 28, lines 45 et seq., or on column 30, lines 3 et seq. and lines 61 et seq.) that ***all reagents and the sample remain in the container***. In other passages, Robinson et al describe the container as a "***closed disposable pack***" (see e.g., column 31, line 17, column 42, line 24). Such teaching is positively against the claimed subject matter.

With respect to the transmission of the forces through the flexible sheet it is further noted that it is well established that ***patent applicant is free to recite features of an apparatus either structurally or functionally*** (see *e.g.*, In re Swinehart, 58 C.C.P.A. 1027, 439 F.2d 210, 212, 169 U.S.P.Q. (BNA) 226, 228 (CCPA 1971)). It should be apparent from the claim language that a ***functional feature of an element in the claimed apparatus is recited***. Therefore, the Office should not consider claim 1-2 and 4-6 as being anticipated by Robinson et al.

Claim 3

To establish prima facie obviousness of a claimed invention, ***all the claim limitations must be taught or suggested by the prior art.*** In re Royka, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). "All words in a claim must be considered in judging the patentability of that claim against the prior art." In re Wilson, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). Claim 3 as rejected is a dependent claim on claim 1. Therefore, all elements recited in claim 1 are included in claim 3 as well.

In her present rejection, the Examiner used Robinson et al as the sole reference against claim 3. Therefore, and as discussed above, ***not all of the elements in the claim are found in the cited reference.*** The Examiner's assertion that substitution of an antibody for a nucleotide probe would have been obvious does not remedy that defect.

Conclusion

In its rush to reject the claims, the Office failed to consider all of the limitations in the presently pending claims, ignored the teaching of the reference as a whole, and further failed to properly establish obviousness. The rejections should be withdrawn.

Respectfully submitted,

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APPENDIX

The below shown independent claims reflect the rejected claims as presently pending and entered in response to the non-final office action dated March 31, 2005.

1. An apparatus comprising:

a container having an outermost wall that is formed at least in part by a flexible top sheet, the container further including a fluid receiving port, a fluid discharge port, and a plurality of compartments fluidly coupled to at least one of the fluid receiving port and the fluid discharge port;

wherein the fluid receiving port is configured to receive a continuous flow of a biological fluid that includes a target antigen, and wherein the fluid discharge port is configured to emit a continuous flow of the biological fluid that is at least partially depleted of the target antigen while the fluid receiving port receives the continuous flow of the biological fluid;

wherein at least one of the compartments further comprises a plurality of magnetic beads that carry an affinity marker that binds the target antigen; and

wherein the target antigen is separated from the biological fluid using a magnetic force and an automatic mechanical force, wherein the magnetic force and the automatic mechanical force are transmitted through the flexible top sheet.

2. The apparatus of claim 1 wherein at least one of the compartments includes a fluid selected from the group consisting of a buffer, a wash fluid, an isotonic fluid, and an elution fluid.

3. The apparatus of claim 1 wherein the affinity marker is selected from the group consisting of an antibody, an antibody fragment, and a lectin.

4. The apparatus of claim 1 wherein at least one of the compartments further includes a port that allows draining of the at least one of the compartments.

5. The apparatus of claim 1 wherein the biological fluid comprises whole blood

6. The apparatus of claim 1 wherein the target antigen is present on any of a stem cell, a diseased cell, a bacterium, and a virus.